

REMARKS

The Examiner rejected claims 1, 3-15, 17-33, and 36-41. Claims 1, 3-5, 7-15, 17-20, 22-33, 38, and 41 have been canceled without prejudice. Claims 6, 21, 36, 37, 39, and 40 have been amended to incorporate the limitations of their base claims. No new matter has been added.

In light of these amendments and the following remarks, Applicants respectfully request reconsideration and allowance of claims 6, 21, 36, 37, 39, and 40.

Information Disclosure Statement

Applicants filed a Supplemental Information Disclosure Statement on September 27, 2002. Applicants respectfully request that the Examiner forward a copy of the initialed Form PTO-1449, indicating that the listed references have been considered. For the Examiner's convenience, a copy of the Form PTO-1449 is attached hereto.

Rejection under 35 U.S.C. § 112

The Examiner rejected claims 1, 3-15, 17-33, and 36-41 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner stated that the term "elevated" in claims 1, 6-9, 13, 21-24, and 36-41 is a relative term that renders the claims indefinite. The Examiner further alleged that the specification does not provide a standard for ascertaining the requisite degree of elevation, and that a person of ordinary skill in the art would not be apprised of the scope of the invention. In addition, the Examiner alleged that the specification fails to disclose either a typical level of expression of the markers or a quantitative measure of when a condition is mild rheumatoid arthritis (RA) as compared to severe RA. Furthermore, the Examiner stated that the definition of severe RA does not encompass lymphotoxin-alpha, SLC, DC-CK1, BLC, or MCP-1. The Examiner rejected claims 3-5, 10-12, 14-20, and 25-35 for depending from an indefinite base claims and for failing to resolve the issues raised above.

Applicants respectfully disagree. The acceptability of claim language depends on "whether one of ordinary skill in the art would understand what is claimed, in light of the specification." See, e.g., MPEP § 2173.05(b). A person having ordinary skill in the art, reading Applicants' specification, would understand the metes and bounds of the claimed subject matter.

For example, Applicants' specification clearly defines an "elevated level" of a marker polypeptide to be any level that is greater than a reference level for that polypeptide. The specification also describes the use of comparable samples to determine whether a particular level is an elevated level. Further, Applicants' specification defines a "reference level" to be a level typically expressed by mammals with mild RA. See, page 7, line 10 to page 8, line 10 of Applicants' specification. Moreover, Applicants' specification teaches that patients with mild RA typically have joint tissue lacking germinal centers (GC), whereas patients with severe RA can have joints with GC. The specification further discloses that elevated levels of SLC and DC-CK are associated with the presence of GC follicles, and thus are associated with severe RA. See, Applicants' specification at page 2, lines 18-22, page 14, lines 24-30, page 15, lines 6-10 and lines 21-30. Thus, the meaning of the term "elevated level" with respect to the recited markers is clear, and the metes and bounds of the claims are definite.

In light of the above, Applicants respectfully request withdrawal of the rejection of claims 6, 21, 36, 37, 39, and 40 under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 103

The Examiner rejected claims 1, 3-5, 7-15, 17-20, 22-33, 38, and 41 under 35 U.S.C. § 103(a) as being unpatentable over Goronzy *et al.* (U.S. Patent No. 6,555,320) in view of Li *et al.* (U.S. Patent No. 6,075,124) and further in view of Kara *et al.* (U.S. Patent No. 6,088,695) and Coli *et al.* (U.S. Patent No. 6,018,713). The Examiner asserted that it would have been *prima facie* obvious to use a marker as disclosed by the Goronzy *et al.* and Li *et al.* references to determine the severity of RA in a mammal by determining whether or not a sample from the mammal contains the marker, and further communicating information about the presence or absence of the marker to a person as disclosed by the Kara *et al.* and Coli *et al.* references.

Applicants respectfully disagree. To further prosecution, however, claims 1, 3-5, 7-15, 17-20, 22-33, 38, and 41 have been canceled without prejudice. Thus, this rejection is moot.

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CONCLUSION

Applicants respectfully submit that claims 6, 21, 36, 37, 39, and 40 are in condition for allowance, which action is requested. The Examiner is invited to telephone the undersigned if such would further prosecution. Applicants believe that no fees are due. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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